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FAX COVER SHEET

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TO: U.S. Patent and Trademark Office - Attn: Group Art Unit 3742

FAX NO.: 703/872-9306

FROM: Frederick H. Gribbell ----- TELEPHONE NO.: (513) 891-2100

DATE: September 1, 2004 S/N: 10/800,540

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COMMENTS/MESSAGE

PATENT**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: John P. Barber, et al. : Art Unit: 3742
Serial No.: 10/800,540 : Examiner: Philip H. Leung
Filed: March 15, 2004
For: **PORTABLE INDUCTION HEATING TOOL FOR SOLDERING PIPES**

**RESPONSE TO RESTRICTION AND
ELECTION OF CLAIMS REQUIREMENTS****RECEIVED
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Dear Sir:

In an Office Action mailed on August 12, 2004, the Examiner has imposed a restriction requirement as between one of several embodiments illustrated in the figures; the Examiner stated that there are several patentably distinct species of the claimed invention, and listed six (6) species along with corresponding drawing numbers from the patent application. The Examiner is requiring Applicants not only to elect a single species, but also to list all claims that are readable on such species. Finally, Applicants must make a provisional election for prosecution on the merits, notwithstanding any traverse.

The Examiner listed the species according to certain figures, as follows:

Species 1: FIGS. 1-2.

Species 2: FIGS. 3-11.

Serial No.: 10/800,540

-1-

Attorney Docket: NEX-509

Species 3: FIGS. 12-13.

Species 4: FIGS. 14-15.

Species 5: FIGS. 16-17, 23.

Species 6: FIGS. 18-20.

List of Species, and Corresponding Description:

- | | | |
|-----------|---|---|
| Species 1 | — | Soldering tool with a heat exchanger and multiple heat pipes in the coil area. |
| Species 2 | — | Soldering tool with a heat exchanger and multiple heat pipes in the coil area, but fewer pipes than in Species 1. |
| Species 3 | — | Soldering tool with a heat exchanger and multiple heat pipes in the coil area, but even fewer pipes than in Species 2 (only two pipes total). |
| Species 4 | — | Soldering tool with a heat exchanger and multiple heat pipes; the heat pipes do not run into the coil area. |
| Species 5 | — | Soldering tool with a heat exchanger, but <i>no</i> heat pipes. |
| Species 6 | — | Soldering tool with <i>no</i> heat exchanger, and <i>no</i> heat pipes. |

List of Claims and Corresponding Species:

Species 1: claims 1-16, 18-32, 35-52.

Species 2: claims 1-16, 18-32, 35-52.

Species 3: claims 1-16, 18-32, 35-52.

Species 4: claims 1-14, 17-52.

Species 5: claims 1-9, 13-14, 23-27, 35-39.

Species 6: claims 1-9, 40-52.

REMARKS

Serial No.: 10/800,540

-2-

Attorney Docket: NEX-509

It should be noted that the only difference between Species 1, 2, and 3 is the number of heat pipes that run into the coil area of the induction soldering tool of the present invention. Applicants believe that these three species are, therefore, not patentably distinct from one another.

The only difference between Species 4 and Species 1-3 is the location of the heat pipes. In Species 1-3, the heat pipes run into the induction coil area; in Species 4, the heat pipes do not run through the mounting wall (and into the induction coil area). It may be true that Species 4 is distinct from Species 1-3, however, it seems clear that the Examiner will have to search the same prior art areas for all four of these species.

It also should be noted that independent claims 1 and 40 are *generic* for all six species of the present invention.

Traverse

Based upon the above information, Applicants respectfully traverse the restriction requirement with regard to species 1-3 because they are not patentably distinct from one another. Applicants also respectfully traverse the restriction requirement with regard to species 1-4 because the Examiner will need to search in the same areas for each of these species (as noted above). Finally, Applicants respectfully traverse the restriction requirement with regard to all listed species 1-6 because they are all covered by two independent claims 1 and 40.

Conclusion, and Provisional Election

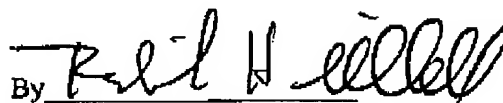
While it is Applicants' position that claims 1 and 40 are generic for the present invention and thus the six species should not be divided from one another, in order to comply with 37 C.F.R. § 1.146, and the Examiner's requirement, Applicant hereby provisionally elects Species 3 for prosecution on the merits. Species 3 is directed to claims 1-16, 18-32, and 35-52.

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Respectfully submitted,

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Serial No.: 10/800,540

-4-

Attorney Docket: NEX-509